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EXAMINER	
RILEY, MARCUS T	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/758,200	RAGUET ET AL.	
	Examiner	Art Unit	
	Marcus T. Riley	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *attached*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

> Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.
>
> When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).
>
> In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim 26 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 26 defines an information carrier embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the

function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed an information carrier can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. **Claims 1-17 and 22-26** are rejected under 35 U.S.C. 102(e) as being anticipated by Ahne et al. (US 7,068,837 B2 hereinafter, Ahne '387).

Regarding claim 1; Ahne '387 discloses a method of managing images on a device comprising at least one means for connection to at least one memory space containing images and selection information selecting images in a first category, non-selected images being images in a second category, the method comprising a prior step of: configuring at least one image management file containing information relating to the management of the images in the first category and to the management of the images in the second category, the image management file being saved in a memory space belonging to the image managing device and different from the memory space containing images and selection information (*"The LCD provided by the stand-alone printer, for example, gives the user the ability to interact and give commands to the printer..A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory. The files can be accessed using a file management system such as the one used on a Palm Pilot. By selecting a file, the user is given the option of editing the fields of the document selected. Once the user has edited the document, he can either print the edited document or store the document back into memory. The documents mentioned above can be of various types. Some examples are address labels, business cards, income tax forms, or commonly printed images. For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer*

gives it. When this option is chosen, the printer is no longer a 'stand-alone' device as defined in the invention background section of this disclosure." column 5, lines 31-53); then, following the connection of a memory space containing images and selection information, the following steps of: obtaining selection information for the images in the connected memory space (*"A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory."* column 5, lines 33-35); managing the images in the first category according to the information in the said at least one configured image management file (*"The files can be accessed using a file management system such as the one used on a Palm Pilot. By selecting a file, the user is given the option of editing the fields of the document selected. Once the user has edited the document, he can either print the edited document or store the document back into memory."* column 5, lines 35-41); and managing the images in the second category using the information in the said at least one configured image management file (*"For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer gives it. When this option is chosen, the printer is no longer a 'stand-alone' device as defined in the invention background section of this disclosure."* column 5, lines 44-53).

Regarding claim 2; Ahne '387 discloses where said memory space is included in or can be inserted in an image processing apparatus (*"A menu option is added to the currently available*

interface software to allow the user to select currently saved files in the printer's memory." column 5, lines 33-35).

Regarding claim 3; Ahne '387 discloses where the connection to a memory space takes place by means of an image processing apparatus (*"The LCD provided by the stand-alone printer, for example, gives the user the ability to interact and give commands to the printer. A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory."* column 5, lines 31-35).

Regarding claim 4; Ahne '387 discloses where the image processing apparatus is able to make a selection of images and to supply image selection information (*"The LCD provided by the stand-alone printer, for example, gives the user the ability to interact and give commands to the printer. A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory."* column 5, lines 31-35).

Regarding claim 5; Ahne '387 discloses where the step of configuring at least one image management file is performed on a device comprising a user interface, distant from the device connected to the memory space (*"For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer gives it. When this option is chosen, the printer is no longer a 'stand-alone' device as defined in the invention background section of this disclosure."* column 5, lines 44-53).

Regarding claim 6; Ahne '387 discloses a step of recognizing the apparatus connected or the memory space connected before the performance of the step of obtaining the selection information (*"For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer gives it. When this option is chosen, the printer is no longer a 'stand-alone' device as defined in the invention background section of this disclosure."* column 5, lines 44-53).

Regarding claim 7; Ahne '387 discloses a step of selecting at least one configured management file corresponding to the apparatus or to the connected memory space (*" The LCD provided by the stand-alone printer, for example, gives the user the ability to interact and give commands to the printer. A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory. The files can be accessed using a file management system such as the one used on a Palm Pilot. By selecting a file, the user is given the option of editing the fields of the document selected."* column 5, lines 31-38).

Regarding claim 8; Ahne '387 discloses where at least one management file corresponds to each processing apparatus or memory card able to be connected to said device (*"For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's*

control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer gives it." column 5, lines 44-52).

Regarding claim 9; Ahne '387 discloses where the image management steps comprise one or more steps of applying a processing function to the images (*"In this event printing is delayed while data processor 17 prepares the employee form in a bit map as required for printing."* column 8, lines 43-45).

Regarding claim 10; Ahne '387 discloses where, with each processing function, a set of parameters is associated, which is usable for the application of the function (*"Printer 1 under control of data processor 17 responds to the following commands to enter forms into non-volatile memory 21: 1) Switch 29 is turned on and printer 1 is brought to the normal printing status. 2) Conventional driver software suitable to printer 1 basic operation is employed at a host computer applying the signals to cable 3. 3) A unique command for storing files is sent on cable 3. 4) A unique command for opening and naming a file containing a form is sent, the name being that which will appear on display 27. 5) With the form prepared by an application program, the "print to file" entry is made to the application program. The user then instructs the application to print the document in the normal manner. The print to file designation causes the application to create the form on the hard disk on the host computer. Once this operation is complete, the user exits the application and sends the file to the printer. 6) A unique command is sent to close the file. 7) A unique command is sent to designate storage of the form in non-volatile memory 21 as a form. Step 4 has designed the data so stored as a form with the name assigned."* column 9, lines 27-52).

Regarding claim 11; Ahne '387 discloses where the processing functions are in the list consisting of image compression, anti red-eye processing, transfer via a messaging service, transfer over a communication network, printing, transcoding or a combination of the above functions (*"Printer 1 under control of data processor 17 responds to the following commands to enter forms into non-volatile memory 21: 1) Switch 29 is turned on and printer 1 is brought to the normal printing status. 2) Conventional driver software suitable to printer 1 basic operation is employed at a host computer applying the signals to cable 3. 3) A unique command for storing files is sent on cable 3. 4) A unique command for opening and naming a file containing a form is sent, the name being that which will appear on display 27. 5) With the form prepared by an application program, the "print to file" entry is made to the application program. The user then instructs the application to print the document in the normal manner. The print to file designation causes the application to create the form on the hard disk on the host computer. Once this operation is complete, the user exits the application and sends the file to the printer. 6) A unique command is sent to close the file. 7) A unique command is sent to designate storage of the form in non-volatile memory 21 as a form. Step 4 has designed the data so stored as a form with the name assigned."* column 9, lines 27-52).

Regarding claim 12; Ahne '387 discloses at least one means for connection to at least one memory space containing images and selection information selecting images in a first category, non-selected images being images in a second category (*" The LCD provided by the stand-alone printer, for example, gives the user the ability to interact and give commands to the printer. A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory. The files can be accessed using a file*

management system such as the one used on a Palm Pilot. By selecting a file, the user is given the option of editing the fields of the document selected. Once the user has edited the document, he can either print the edited document or store the document back into memory. The documents mentioned above can be of various types. Some examples are address labels, business cards, income tax forms, or commonly printed images. For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer gives it. When this option is chosen, the printer is no longer a 'stand-alone' device as defined in the invention background section of this disclosure." column 5, lines 31-53); at least one memory space belonging to the image managing device, different from the memory space containing images and selection information, and including at least one configurable image management file containing information on the management of the images in the first category and on the management of the images in the second category (*"The LCD provided by the stand-alone printer, for example, gives the user the ability to interact and give commands to the printer. A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory. The files can be accessed using a file management system such as the one used on a Palm Pilot. By selecting a file, the user is given the option of editing the fields of the document selected. Once the user has edited the document, he can either print the edited document or store the document back into memory. The documents mentioned above can be of various types. Some examples are address labels, business cards,*

income tax forms, or commonly printed images. For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer gives it. When this option is chosen, the printer is no longer a 'stand-alone' device as defined in the invention background section of this disclosure." column 5, lines 31-53); means for obtaining selection information for the images in the connected memory space (*"A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory."* column 5, lines 33-35); means for managing the images in the first category according to the information in said at least one configured image management file (*"The files can be accessed using a file management system such as the one used on a Palm Pilot. By selecting a file, the user is given the option of editing the fields of the document selected. Once the user has edited the document, he can either print the edited document or store the document back into memory."* column 5, lines 35-41); means for managing the images in the second category according to the information in said at least one configured image management file (*"For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer gives it. When this option is chosen, the printer is*

no longer a 'stand-alone' device as defined in the invention background section of this disclosure." column 5, lines 44-53).

Regarding claim 13; Ahne '387 discloses where said memory space is included in or can be inserted in an image processing apparatus (*"A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory."* column 5, lines 33-35).

Regarding claim 14; Ahne '387 discloses where the connection to a memory space is made by means of an image processing apparatus (*"The LCD provided by the stand-alone printer, for example, gives the user the ability to interact and give commands to the printer. A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory."* column 5, lines 31-35).

Regarding claim 15; Ahne '387 discloses where the image processing apparatus is able to make a selection of images and to supply image selection information (*"The LCD provided by the stand-alone printer, for example, gives the user the ability to interact and give commands to the printer. A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory."* column 5, lines 31-35).

Regarding claim 16; Ahne '387 discloses where for recognizing an image processing apparatus or a memory space which is connected to it (*"For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's control program on the PC. The*

control program then finds and prints the correct file based on the memory location that the printer gives it. When this option is chosen, the printer is no longer a 'stand-alone' device as defined in the invention background section of this disclosure." column 5, lines 44-53).

Regarding claim 17; Ahne '387 discloses where the image management means are means for applying processing functions to the images (*"In this event printing is delayed while data processor 17 prepares the employee form in a bit map as required for printing."* column 8, lines 43-45).

Regarding claim 22; Ahne '387 discloses image transcoding means (*"When the file is stored in 'print format', the printer is able to print the file with less processing time being required. In the preferred implementation of the present invention, this 'print format' is a bitmap file."* column 5, lines 27-30).

Regarding claim 23; Ahne '387 discloses where an image management device characterized in that it is integrated in a printer (*"Printer 1 under control of data processor 17 responds to the following commands to enter forms into non-volatile memory 21: 1) Switch 29 is turned on and printer 1 is brought to the normal printing status. 2) Conventional driver software suitable to printer 1 basic operation is employed at a host computer applying the signals to cable 3. 3) A unique command for storing files is sent on cable 3. 4) A unique command for opening and naming a file containing a form is sent, the name being that which will appear on display 27. 5) With the form prepared by an application program, the "print to file" entry is made to the application program. The user then instructs the application to print the document in the normal manner. The print to file designation causes the application to create the form on the hard disk*

on the host computer. Once this operation is complete, the user exits the application and sends the file to the printer. 6) A unique command is sent to close the file. 7) A unique command is sent to designate storage of the form in non-volatile memory 21 as a form. Step 4 has designed the data so stored as a form with the name assigned." column 9, lines 27-52).

Regarding claim 24; Ahne '387 discloses a printer comprising: at least one means for connection to at least one memory space containing images and selection information selecting images in a first category, non-selected images being images in a second category (*" The LCD provided by the stand-alone printer, for example, gives the user the ability to interact and give commands to the printer. A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory. The files can be accessed using a file management system such as the one used on a Palm Pilot. By selecting a file, the user is given the option of editing the fields of the document selected. Once the user has edited the document, he can either print the edited document or store the document back into memory. The documents mentioned above can be of various types. Some examples are address labels, business cards, income tax forms, or commonly printed images. For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer gives it. When this option is chosen, the printer is no longer a 'stand-alone' device as defined in the invention background section of this disclosure."* column 5, lines 31-53); at least one memory space belonging to the printer, different from the memory space

containing images and selection information, and including at least one configurable image management file containing information on the management of the images in the first category and on the management of the images in the second category (*"The LCD provided by the stand-alone printer, for example, gives the user the ability to interact and give commands to the printer. A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory. The files can be accessed using a file management system such as the one used on a Palm Pilot. By selecting a file, the user is given the option of editing the fields of the document selected. Once the user has edited the document, he can either print the edited document or store the document back into memory. The documents mentioned above can be of various types. Some examples are address labels, business cards, income tax forms, or commonly printed images. For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer gives it. When this option is chosen, the printer is no longer a 'stand-alone' device as defined in the invention background section of this disclosure."* column 5, lines 31-53); means for obtaining selection information for the images in the connected memory space (*"A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory."* column 5, lines 33-35); means for managing the images in the first category according to the information in said at least one configured image management file (*"The files can be accessed using a file management system such as the one used on a Palm*

Pilot. By selecting a file, the user is given the option of editing the fields of the document selected. Once the user has edited the document, he can either print the edited document or store the document back into memory." column 5, lines 35-41); and means for managing the images in the second category using the information in said at least one configured image management file (*"For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer gives it. When this option is chosen, the printer is no longer a 'stand-alone' device as defined in the invention background section of this disclosure."* column 5, lines 44-53).

Regarding claim 25; Ahne '387 discloses an information carrier, possibly totally or partially removable, which can be read by a computer system, containing instructions for a computer program for implementing the image management method (*"Two possible ways that files can be stored in the printer's nonvolatile memory are: the files are sent to the printer directly from the computer; or the files are read from a removable storage media device. When a file is copied to the printer's memory directly from the computer, the user has the choice of either keeping the file in its original format or in a 'print format'. By keeping the file in its original format, it is still readable if it is copied from the printer's memory back to the computer, or to a removable storage media device."* column 5, lines 15-25).

Regarding claim 26; Ahne '387 discloses a computer program stored on an information carrier, said program comprising instructions for implementing the image management method

according to claim 1 when it is loaded in and executed by a computer system (*"Two possible ways that files can be stored in the printer's nonvolatile memory are: the files are sent to the printer directly from the computer; or the files are read from a removable storage media device. When a file is copied to the printer's memory directly from the computer, the user has the choice of either keeping the file in its original format or in a 'print format'. By keeping the file in its original format, it is still readable if it is copied from the printer's memory back to the computer, or to a removable storage media device. However, the printer must convert the original format into a printable format before being able to print the document. When the file is stored in 'print format', the printer is able to print the file with less processing time being required. In the preferred implementation of the present invention, this 'print format' is a bitmap file."* column 5, lines 15-30).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 18-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahne '387 in combination with Igarashi et al. (US 6,934,048 B2 hereinafter, Igarashi '048).

Regarding claim 18; Ahne '387 discloses at least one means for connection to at least one memory space containing images and selection information selecting images in a first category, non-selected images being images in a second category (*" The LCD provided by the*

stand-alone printer, for example, gives the user the ability to interact and give commands to the printer. A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory. The files can be accessed using a file management system such as the one used on a Palm Pilot. By selecting a file, the user is given the option of editing the fields of the document selected. Once the user has edited the document, he can either print the edited document or store the document back into memory. The documents mentioned above can be of various types. Some examples are address labels, business cards, income tax forms, or commonly printed images. For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer gives it. When this option is chosen, the printer is no longer a 'stand-alone' device as defined in the invention background section of this disclosure." column 5, lines 31-53); at least one memory space belonging to the image managing device, different from the memory space containing images and selection information, and including at least one configurable image management file containing information on the management of the images in the first category and on the management of the images in the second category (*"The LCD provided by the stand-alone printer, for example, gives the user the ability to interact and give commands to the printer. A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory. The files can be accessed using a file management system such as the one used on a Palm Pilot. By selecting a file, the user is given*

the option of editing the fields of the document selected. Once the user has edited the document, he can either print the edited document or store the document back into memory. The documents mentioned above can be of various types. Some examples are address labels, business cards, income tax forms, or commonly printed images. For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the printer's control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer gives it. When this option is chosen, the printer is no longer a 'stand-alone' device as defined in the invention background section of this disclosure." column 5, lines 31-53); means for obtaining selection information for the images in the connected memory space (*"A menu option is added to the currently available interface software to allow the user to select currently saved files in the printer's memory."* column 5, lines 33-35); means for managing the images in the first category according to the information in said at least one configured image management file (*"The files can be accessed using a file management system such as the one used on a Palm Pilot. By selecting a file, the user is given the option of editing the fields of the document selected. Once the user has edited the document, he can either print the edited document or store the document back into memory."* column 5, lines 35-41); means for managing the images in the second category according to the information in said at least one configured image management file (*"For documents that are too large to be stored on the printer's memory, the user has the option of storing only the document's PC memory location on the printer. Thus, when the user chooses to 'speed print' a file for which this option has been chosen, the printer 'wakes up' the*

printer's control program on the PC. The control program then finds and prints the correct file based on the memory location that the printer gives it. When this option is chosen, the printer is no longer a 'stand-alone' device as defined in the invention background section of this disclosure." column 5, lines 44-53).

Ahne '387 does not expressly disclose an image management device according to claim 12, comprising access to a network of the Internet type.

Igarashi '048 discloses an image management device according to claim 12, comprising access to a network of the Internet type (*"In addition, the access method refers to, but is not limited to, a personal computer, cellular phone, PDA, or the like that can access said storage means via the Internet."* column 3, lines 34-36).

Ahne '387 and Igarashi '048 are combinable because they are from same field of endeavor of image processing systems (*"The present invention relates to an image data processing system..."* Igarashi '048 at column 1, lines 5-6).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the image processing system as taught by Ahne '387 by adding a an image management device according to claim 12, comprising access to a network of the Internet type as taught by Igarashi '048.

The motivation for doing so would have been because it advantageous to supply an image data processing system that is easy for both the customer and the service provider to use (*"...to supply an image data processing system that is easy for both the customer and the service provider to use."* Igarashi '048 at column 1, lines 66-67 thru column 2, lines 1-2).

Therefore, it would have been obvious to combine Ahne '387 with Igarashi '048 to obtain the invention as specified in claim 12.

Regarding claim 19; Igarashi '048 discloses an image management device according to claim 12, comprising an access to a messaging service (*"In addition, the access method refers to, but is not limited to, a personal computer, cellular phone, PDA, or the like that can access said storage means via the Internet."* column 3, lines 34-36).

Regarding claim 20; Igarashi '048 discloses an image management device according to claim 12, comprising an access to a printer (*"In addition, the access method refers to, but is not limited to, a personal computer, cellular phone, PDA, or the like that can access said storage means via the Internet."* column 3, lines 34-36).

Regarding claim 21; Igarashi '048 discloses an image management device according to claim 12, comprising an access to a storage means (*"In addition, the access method refers to, but is not limited to, a personal computer, cellular phone, PDA, or the like that can access said storage means via the Internet."* column 3, lines 34-36).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus T. Riley whose telephone number is 571-270-1581. The examiner can normally be reached on Monday - Friday, 7:30-5:00, est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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